

reading means for reading the data of address information analyzed by the analyzing means; and

format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer.

#### REMARKS

Claims 1-3, 5 and 7-20 are pending. By this Amendment, the specification is amended; claims 4 and 6 are cancelled; claims 1 and 18 are amended to commonly recite that the computer-side referring means is provided at the computer-side for displaying the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected; and claims 14, 19 and 20 are amended to further recite wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer.

Reconsideration based on the above amendments and following remarks is respectfully.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. Entry of the amendments is thus respectfully requested.

The attached Appendix includes marked-up copies of each rewritten paragraph (37 C.F.R. §1.121(b)(1)(iii)) and claim (37 C.F.R. §1.121(c)(1)(ii)).

Applicants thank Examiner Pokrzywa and Primary Examiner Nguyen for the courtesy extended to Applicants' representative during the November 8 personal interview. The substance of the personal interview is incorporated in the Remarks below.

**I. THE CLAIMS DEFINE ALLOWABLE SUBJECT MATTER**

The Office Action rejects claims 14-17, 19 and 20 under 35 U.S.C. §102(b) over WO/9710668 to Kulakowski; claims 1, 2, 8 and 18 under 35 U.S.C. §103(a) over U.S. Patent No. 6,009,153 to Houghton et al. in view of U.S. Patent No. 5,872,845 to Feder; claims 3-6 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder, and further in view of U.S. Patent No. 6,157,463 to Kitagawa; claims 7 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder, and further in view of Kitagawa and further in view of U.S. Patent No. 6,157,706 to Rachelson; and claims 9-13 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder, and further in view of Rachelson. These rejections are respectfully traversed.

Claims 1 and 18 have been amended to overcome the rejections. Claims 1 and 18 recite computer-side referring means provided at the computer side for displaying the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected. Houghton et al. and Feder do not disclose or suggest the recited feature.

Feder discloses a technique to carry out facsimile transmission via a digital network. However, Feder fails to disclose nor suggest computer-side referring means provided at the computer side for displaying the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee

identification information is selected. Accordingly, even if Feder is combined with Houghton et al., the claimed invention cannot be reached. Therefore, claims 1 and 8 are submitted to be allowable.

Kitagawa and Rachelson do not make up for these deficiencies.

For at least these reasons, the combination of Houghton et al. and Feder does not render obvious the subject matter of claims 1, 2, 8 and 18; the combination of Houghton et al., Feder and Kitagawa does not render obvious the subject matter of claims 3-6, the combination of Houghton et al., Feder, Kitagawa and Rachelson does not render obvious the subject matter of claim 7; and combination of Houghton et al, Feder and Rachelson does not render obvious the subject matter of claims 9-13, all under 35 U.S.C. §103(a). Withdrawal of the rejection of claims 1, 2, 8 and 18 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder; claims 3-6 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder, and further in view of Kitagawa; claim 7 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder, and further in view of Kitagawa and further in view of Rachelson; and claims 9-13 under 35 U.S.C. §103(a) over Houghton et al. in view of Feder, and further in view of Rachelson is respectfully requested.

As discussed during the interview, claims 14, 19 and 20 are now amended to further recite "wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer."

Kulakowski discloses an arrangement for reading data of e-mail address and telephone number corresponding to the e-mail address. However, Kulakowski does not disclose nor suggest analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation and reading means for reading the data of address information analyzed by the

analyzing means, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer. Furthermore, Kulakowski does not disclose nor suggest format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission as recited in claim 14, although disclosing a network service provider computer system 18 converting a format of the e-mail message in accordance with required internet protocols. Accordingly, the invention claimed in claims 14, 19 and 20 are clearly distinct from Kulakowski. Therefore, Applicants respectfully submit that claims 14, 19 and 20 are allowable.

For at least these reasons, Kulakowski does not anticipate the subject matter of claims 14-17, 19 and 20 under 35 U.S.C. §102(b). Withdrawal of the rejection of claims 14-17, 19 and 20 under 35 U.S.C. §102(b) over Kulakowski is respectfully requested.

## **II. CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the Applicants' representative at the telephone number listed below.

Respectfully submitted,



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Attachment:  
Appendix  
Petition for Extension of Time

Date: November 18, 2002

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<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
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## APPENDIX

## Changes to Specification:

Page 2, line 27 - page 3, line 13:

The present invention provides a facsimile system comprising a facsimile machine reading image data from an original, a computer transmitting to and receiving from the facsimile machine data of addressee identification information indicative of at least a name of addressee and a facsimile number corresponding to the name of addressee, computer-side storage means provided at a computer side for storing the data of addressee identification information, computer-side referring means provided at the computer side for ~~referring~~ to displaying the addressee identification information fetched out of the computer as well as the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected, and instruction means provided in the facsimile machine so as to be instructed at a facsimile machine side to refer via the computer-side referring means to the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission.

## Changes to Claims:

Claims 4 and 6 are canceled.

The following is a marked-up version of the amended claims:

1. (Twice Amended) A facsimile system comprising:
  - a facsimile machine reading image data from an original;
  - a computer transmitting to and receiving from the facsimile machine data of addressee identification information indicative of at least a name of addressee and a facsimile number corresponding to the name of addressee;

computer-side storage means provided at a computer side for storing the data of addressee identification information;

112 2nd. computer-side referring means provided at the computer side for displaying the addressee identification information fetched out of the computer as well as referring to the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission so that a desired piece of addressee identification information is selected; and

instruction means provided in the facsimile machine so as to be instructed at a facsimile machine side to refer via the computer-side referring means to the data of addressee identification information stored in the computer-side storage means in case of facsimile transmission.

14. (Three Times Amended) An internet facsimile machine capable of executing facsimile transmission via an internet to an addressee using a computer installed with an application program for execution of internet facsimile transmission, comprising:

analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation;

reading means for reading the data of address information analyzed by the analyzing means; and

format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer.

18. (Twice Amended) A facsimile system comprising:

a facsimile machine reading image data from an original;

a computer transmitting to and receiving from the facsimile machine data of addressee identification information indicative of at least a name of addressee and a facsimile number corresponding to the name of addressee;

a computer-side storage circuit provided at a computer side for storing the data of addressee identification information;

112 2-5 a computer-side referring circuit provided at the computer side for displaying the addressee identification information fetched out of the computer as well as referring to the data of addressee identification information stored in the computer-side storage circuit in case of facsimile transmission so that a desired piece of addressee identification information is selected; and

an instruction circuit provided in the facsimile machine so as to be instructed at a facsimile machine side to refer via the computer-side referring circuit to the data of addressee identification information stored in the computer-side storage circuit in case of facsimile transmission.

19. (Twice Amended) An internet facsimile machine capable of executing facsimile transmission via an internet to an addressee using a computer installed with an application program for execution of internet facsimile transmission, comprising:

an analyzing circuit for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation;

a reading circuit for reading the data of address information analyzed by the analyzing circuit; and

a format converting circuit for converting the read data of address information into address information with a format used on the application program for execution of



internet facsimile transmission, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer.

20. (Three Times Amended) A recording medium for recording a program for operating a facsimile machine using a computer installed with an application program for execution of internet facsimile transmission, the program realizing the functions of:

analyzing means for analyzing a data structure of data of address information registered on the basis of an electronic mail application program which is already in operation;

reading means for reading the data of address information analyzed by the analyzing means; and

format converting means for converting the read data of address information into address information with a format used on the application program for execution of internet facsimile transmission, wherein the application program for execution of internet facsimile transmission and the electronic mail application program are independently operating application programs using the computer.